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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,509	01/26/2001	Kazuhisa Hayakawa	080542/0155	6118

7590

06/05/2002

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EXAMINER

SHEWAREGED, BETELHEM

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 06/05/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

MF-3

Office Action Summary	Application No.	Applicant(s)	
	09/769,509	HAYAKAWA ET AL.	
	Examiner	Art Unit	
	Betelhem Shewareged	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>1,2</u> . | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an adequate written description of the invention. The applicant has failed to incorporate a foreign test standard in the specification.

3. The incorporation of essential material by reference to a foreign application or foreign patent or to a publication inserted in the specification is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or applicants attorney or agent, stating that the amendatory material consists of the same application. *In re Hawkins*, 486 F.2d 569, 179 USPQ 157; *In re Hawkins*, 486 F.2d 569, 179 USPQ 163; *In re Hawkins*, 486 F.2d 569, 179 USPQ 167.

4. In order to avoid a 35 U.S.C. § 112, first paragraph rejection when the applicant attempts to incorporate a foreign test standard in the specification (see page 10, line 18), it is recommended that the applicant further incorporates the standard in the specification or submit an English translation of the standard.

5. Claims 1-16 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

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Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

7. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Sargeant et al. (US 6,146,770).

Sargeant discloses an ink jet recording medium comprising a substrate, an ink absorbent layer onto the substrate, and a barrier layer onto the ink absorbent layer, wherein the barrier layer comprises cellulose ether derivative (col. 2, lines 26-37). The barrier layer is equivalent to the claimed cellulose ether film. The recording medium can be used for overhead presentation (col. 1, line 22).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sargeant et al. (US 6,146,770) in view of Shaw-Klein et al. (US 6,361,853) and web site posted by Shin-Etsu Chemical Co., Ltd.

Sargeant discloses an ink jet recording medium comprising a substrate, an ink absorbent layer onto the substrate, and a barrier layer onto the ink absorbent layer, wherein the barrier layer comprises cellulose ether derivative (col. 2, lines 26-37). The barrier layer is equivalent to the claimed cellulose ether film. The recording medium can be used for overhead presentation (col. 1, line 22). Sargeant does not disclose the claimed cellulose ether derivatives.

Shaw-Klein teaches ink jet recording element comprising a support, absorbing layer, adhesion promoting layer, and overcoat layer in the order recited. The overcoat layer comprises methyl cellulose, hydroxypropylmethyl cellulose, hydroxypropyl cellulose or sodium carboxymethyl cellulose (col. 2, line 31).

Sargeant and Shaw-Klein are analogous art because they are from the same field of endeavor that is the ink jet receiving art. At the time of the invention, it would have been obvious to the person of ordinary skill in the art to combine the cellulose ether derivatives of Shaw-klein's with the barrier layer of Sargeant so as to provide a layer having excellent image quality.

Claims 3 and 4 are directed to product by process claims because the water does not exist in the final product. In view of the specification, the water is dried out during the process of making the claimed cellulose ether film. Furthermore, undissolved fibers would remain in the solution containing water and cellulose ether because the

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cellulose ether would not completely dissolve. The hydroxyl groups are creating strong hydrogen bonding and preventing water from flowing into the interval between the cellulose molecules. The above teaching is supported by a web site posted by Shin-Etsu Chemical Co., Ltd.

Sargeant does not disclose the claimed number of fibers and size of fibers. The experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. One of ordinary skill in the art would have been motivated to adjust the number of fibers and size of fibers in order to optimize the transparency of the film. The higher the number of the fibers and/or the bigger the size of the fibers the less transparency the film. A prima facie case of obviousness may be rebutted, however, where the results of the optimizing variable, which is known to be result-effective, are unexpectedly good. *In re Boesch and Slaney*, 205 USPQ 215.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 703-305-0389. The examiner can normally be reached on Mon.-Thur. 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on 703-308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-305-3599 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700



BS *BS*
June 3, 2002.